

## **REMARKS/ARGUMENTS**

The Office Action of September 8, 2006 has been carefully reviewed and these remarks and request for continued examination are Applicant's response thereto. Claims 19, 21-34, 36-41, and 45-51 are pending. Claims 19, 21-24, 28, 29, 34-39, 41, 45-49 and 50-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,265 to Rangan *et al.* (Rangan) in view of U.S. Patent No. 6,459,906 to Yang (Yang) in further view of U.S. Patent No. 6,332,127 to Bandera *et al.* (Bandera). Claims 25-27, 30-33 and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rangan in view of Yang and in further view of Bandera and in further view of U.S. Patent No. 6,198,9335 to Saha *et al.* (Saha). In response, Applicant respectfully traverses the rejection in view of the remarks that follow.

### **Rejection under 35 U.S.C § 103(a)**

All pending claims stand rejected under 35 U.S.C. § 103(a) in view of the Rangan, Yang and Bandera, with or without Saha.

Looking first at claim 19, Applicant notes that claim 19 is directed toward a method. Applicant further notes that it is axiomatic that a new process for an existing machine is patentable. Furthermore, it is insufficient to simply find the recited steps being made in a number of distinct references and suggest it would have been obvious to perform all the steps together in one device that cannot perform all the steps. This is because it would impossible to perform all the steps on the device and at a minimum, a person of skill in the art would have no expectation of success in performing all the steps with a device that cannot perform all the steps in the first place.

In other words, Applicant respectfully submits that the rejection of a method such as is recited claim 19 should first point to a disclosure of a device that could perform all the steps and then point to a teaching that discloses performing the missing step(s) along with some sort of motivation to add the additional features in the initial device. The current rejection fails to do this. Instead it first suggests that a combination of references disclose a device with all the required functionality. Then it suggests, after the device is formed based on the combination of the references, that it would be obvious to perform the recited steps by pointing to steps being performed in the difference references. In other words, the Office Action is first forming a

device based on a combination of references (without any teaching suggesting the formation of the device) and once the device is formed, selecting a number of steps from the different references to show the recited method is obvious, even though none of the references actually perform all the steps or provide any teaching of performing all the steps in a device that includes the necessary functionality. This type of tiered rejection is unsupported. Indeed, it seems that the only way one could generate such a method is with improper hindsight reconstruction using the present application as a roadmap to pick and choose features from various references to reach the presently claim subject matter.

To make the tiered rejection even worse, the motivation to combine the features of Bandera with Rangan only comes into existence after Rangan is first modified with Yang. This is because the Office Action indicates that Bandera is directed toward a mobile communication device while the Office Action admits that Rangan is not. Indeed, the Office Action's suggestion that it would be obvious to combine Bandera with Yang merely emphasizes the problem because Bandera is being combined with Rangan, not Yang. Applicant asserts it is improper to modify a first reference with a second reference and then modify the already modified first reference again based on the fact that the first modified reference now has functionality that could be used with additional references. If such a rejection were proper, no process could be patented unless at least one of the steps have never been performed before. Plainly, however, there is no support for such a standard.

In addition to the improper tiered nature of the rejection, the Office Action has failed to provide any motivation for the dual use of the mobile communication network in combination with the digital broadcasting network. According to the Office Action, Rangan teaches the use of a digital network and Yang teaches the use of mobile device. Claim 19, however, recites in part, the steps of “displaying a link to a resource ... wherein the link is related to a product and a position of the link is in a video displayed on the mobile terminal ..., wherein the video is received via the digital broadcasting network” and “enabling the mobile terminal to display the related content, the related content being provided over the mobile communication network” (emphasis added). Thus, claim 19 recites using both the digital broadcasting network and the mobile communication network. While Bandera may disclose the use of a mobile

communication network, the Office Action has provided no support for why a person of skill in the art would combine the use of a mobile communication network in the system of Rangan, nor would any exist because, as the Office Action admits, Rangan is not directed toward a mobile device. The Office Action, therefore, has failed to provide any support for the motivation to combine two networks together. Accordingly, the cited references fail to support a *prima facie* case of obviousness.

In addition, and perhaps even more importantly, claim 19 recites “enabling the mobile terminal to display the related content, the related content being provided over the mobile communication network.” No support has been provided for providing the related content over the mobile communication network because Rangan, to the extent it may be construed as suggested in the Office Action, merely teaches to provide the related content over a digital network.

Thus, the rejection of claim 19 lacks support because: 1) it used a tiered rejection methodology that is unsupported by any case law or statutory authority, 2) no motivation to combine the use of two different networks was shown, and 3) at least one step of claim 19 is not present in the references of record, even under the improper tiered combination. In view of the above, the references of record cannot fairly be said to support a *prima facie* case of obviousness with respect to claim 19. Therefore, Applicants respectfully assert that claim 19 is patentable over the references of record.

Independent claims 28, 34, 36, 41 and 50 all include features similar to the above recited features of claim 19. Thus, for at least the reasons discussed above, all pending independent claims are patentable over the references of record.

The remaining pending claims 21-27, 29-33, 37-40, 45-49 and 51 depend from one of the above independent claims. Therefore, dependent claims 21-27, 29-33, 37-40, 45-49 and 51 are patentable over the references of record for at least the reasons discussed above and for the additional features recited therein. For example, Applicants note that a person of skill in the art would not be motivated to add the features of Saha to the device of Rangan unless Rangan was first modified based on Yang – further emphasizing the improper tiered nature of the rejection.

Accordingly, for at least the above reasons this ground of rejection should be withdrawn.

Appln. No.: 09/580,583  
Response dated December 8, 2006  
Reply to Office Action of September 8, 2005

**CONCLUSION**

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

Dated: December 8, 2006

By: /Stephen L. Sheldon/  
Stephen L. Sheldon  
Registration No. 58,732

BANNER & WITCOFF, LTD.  
10 S. Wacker Drive, Suite 3000  
Chicago, IL 60606-7407  
Telephone: 312-463-5000  
Facsimile: 312-463-5001